

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors).

“The factual inquiry whether to combine references must be thorough and searching.” Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

With respect to Lee's application, neither the examiner nor the

Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Deferential judicial review under the Administrative Procedure Act does not relieve the agency of its obligation to develop an evidentiary basis for its findings. To the contrary, the Administrative Procedure Act reinforces this obligation. See, e.g., Motor Vehicle Manufacturers Ass'n v. State Farm Mutual Automobile Ins. Co., 463 U.S. 29, 43 (1983) ("the agency must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'") (quoting Burlington Truck Lines v. United States, 371 U.S. 156, 168 (1962)); Securities & Exchange Comm'n v. Chenery Corp., 318 U.S. 80, 94 (1943) ("The orderly function of the process of review requires that the grounds upon which the administrative agency acted are clearly disclosed and adequately sustained.").

In its decision on Lee's patent application, the Board rejected the need for "any specific hint or suggestion in a particular reference" to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. See Motor Vehicle Manufacturers, 463 U.S. at 43 ("an agency rule would be arbitrary and capricious if the agency . . . entirely failed to consider an important aspect of the problem"); Mullins v. Department of Energy, 50 F.3d 990, 992 (Fed. Cir. 1995) ("It is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action."). As discussed in National Labor Relations Bd. v. Ashkenazy Property Mgt. Corp., 817 F.2d 74, 75 (9th Cir. 1987), an agency is "not free to refuse to follow circuit precedent."

The foundation of the principle of judicial deference to the rulings

of agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency's application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See Baltimore and Ohio R. R. Co. v. Aberdeen & Rockfish R. R. Co., 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would become lost "in the haze of so-called expertise"). The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See Allentown Mack, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle")

The case on which the Board relies for its departure from precedent, In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969), indeed mentions "common knowledge and common sense," the CCPA stating that the phrase was used by the Solicitor to support the Board's conclusion of obviousness based on evidence in the prior art. Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge.

In re Lee, 61 U. S. P. Q. 2d 1430, 1433-1435, (Fed. Cir. Jan. 18, 2002).

Under Lee, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See M.P.E.P. Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria. M.P.E.P. § 2142.

[V]irtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed.Cir.1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). An examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.

In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998), citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ.2d 1551, 1554 (Fed. Cir. 1996).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Claim 1 claims a method of treatment of a scar comprising alternately applying a topical fluid silicone gel not released from silicone gel sheeting to the scar, and applying silicone gel sheeting to the scar.

Claim 2 adds to the recitations of claim 1 wiping off the excess fluid silicone gel to leave a thin layer of the fluid silicone gel on the scar.

Claim 4 claims a method of treatment of a scar comprising treating the scar with laser therapy, and applying a topical fluid silicone gel not released from silicone gel sheeting to the scar. Claims 5 to 12 claim specifics of the laser therapy step of the claim 4 treatment.

Kushner discloses use of non-volatile silicone fluid, fumed silica and a volatile diluent as wound dressings in the treatment of scars. Kushner, col. 1, lines 4-5, col. 4, lines 7-9. Kushner contains no mention of laser therapy. Kushner neither discloses nor suggests the desirability of alternately applying a topical fluid silicone gel not released from silicone gel sheeting to the scar, and applying silicone gel sheeting to the scar. Kushner neither discloses nor suggests the desirability of wiping off the excess fluid silicone gel to leave a thin layer of the fluid silicone gel on the scar. Kushner neither discloses nor suggests the desirability of treating the scar with laser therapy, and applying a topical fluid silicone gel not released from silicone gel sheeting to the scar.

Lee discloses a method of elevating scar surface temperature to stimulate collagenase activity by covering a scar with a thermal insulating material containing a therapeutically effective amount of a medicament. Lee teaches away from the use of silicones:

In a most preferred embodiment, the thermal material employed in the method of the present invention is a hydrogel. Hydrogels are three-dimensional networks of hydrophilic polymers, generally covalently or ionically cross-linked, which interact with aqueous solutions by swelling to some equilibrium value. Hydrophilic polymers of which such gels can be composed can be either synthetic or naturally occurring polymers, or combinations of both. The water content of such gels can also vary over a wide range, depending on the chemical identity of the polymers involved, as well as the desired physical characteristics of the resulting composition. Such gels have seen wide use in a number of applications, such as for wound dressings. In this regard, the disclosures of the following U. S. Pat. Nos. are herein incorporated by reference: 5,013,769 to Murray et al; 4,909,244 to Quarfoot et al.; 4,659,700 to Jackson; 4,646,730 to Schonfeld et al; and 3,419,006 to Warwick.

Gels of these types possess desirable thermal and mechanical properties, as well as the necessary biological compatibility. For example, due to the high composition of water in these materials, the heat capacity of these gels is very high, much higher than that for the silicone-based gels, discussed supra, that also see extensive use as wound dressings.

Lee, col. 9, lines 10-33, italics Applicant's. Lee quite clearly teaches away from the use of x-ray irradiation in the treatment of scars:

"Existing therapy for hypertrophic scars and keloids includes surgery, mechanical pressure, steroids, x-ray irradiation and cryotherapy. There are many disadvantages associated with each of these methods. Surgical removal of the scar tissue is often incomplete and can result in the development of hypertrophic scars and keloids at the incision and suture points. Steroid treatments are unpredictable and often result in depigmentation of the skin. X-ray therapy is the only predictably effective treatment to date; however,

because of its potential for causing cancer, it is not generally recommended or accepted.”

Lee, col. 4, lines 54-64, italics Applicant’s.

Lee contains no mention of laser therapy. Lee discourages the skilled artisan from considering x-ray therapy and therefore cannot be held to render obvious the present claimed invention. Teaching away is the antithesis of obviousness and eviscerates the motivation necessary for the development of a *prima facie* case of obviousness. Lee neither discloses nor suggests the desirability of alternately applying a topical fluid silicone gel not released from silicone gel sheeting to the scar, and applying silicone gel sheeting to the scar. Lee neither discloses nor suggests the desirability of wiping off the excess fluid silicone gel to leave a thin layer of the fluid silicone gel on the scar. Lee neither discloses nor suggests the desirability of treating the scar with laser therapy, and applying a topical fluid silicone gel not released from silicone gel sheeting to the scar.

Tankovich discloses a process for transforming relatively deep sub-epidermal formations of undesirable tissue by heating water in the formations with a laser having a wavelength of about 1450 nm to 1680 nm. Tankovich, col. 1, lines 17-20, col. 2, lines 20-28, claims 1 and 5. Tankovich contains no mention of the use of silicone fluids in the treatment of hypertrophic or keloid scars.

Tankovich discloses using an Er:Glass laser that operates at 1540 nm. Tankovich, col. 4, lines 32-33. Tankovich discourages and teaches away from using lasers with wavelengths less than or about 1000 nm, such as the dye laser with wavelength between 550 nm and 650 nm. Tankovich, col. 4, lines 24-30. Tankovich discloses that

the Dye laser produces wavelengths that have a substantial level of oxyhemoglobin absorption. As a result, the Dye laser causes hemoglobin in the erythrocytes to be exploded, causing blood vessel eruption. For some patients, this process may not be satisfactory. In particular, with small formations such as spider veins and telangiectasia, this approach typically provides only a short term cosmetic correction of the tissue. Moreover, even after extended periods of convalescence, many of these patients still experience significant scarring.

Tankovich, col. 1, line 63 to col. 2, line 5. Again, Tankovich teaches away from the present invention, eviscerates the motivation necessary for the presentation of a *prima facie* case of obviousness, and thus cannot render the present invention obvious. Tankovich neither discloses nor suggests the desirability of alternately applying a topical fluid silicone gel not released from silicone gel sheeting to the scar, and applying silicone gel sheeting to the scar. Tankovich neither discloses nor suggests the desirability of wiping off the excess fluid silicone gel to leave a thin layer of the fluid silicone gel on the scar. Tankovich neither discloses nor suggests the

treating the scar with laser therapy, and applying a topical fluid silicone gel not released from silicone gel sheeting to the scar.

There is no disclosure or suggestion of the desirability of combining any element or combination of elements from Kushner with any element or combination of elements from Lee. There is no disclosure or suggestion of the desirability of combining any element or combination of elements from Lee with any element or combination of elements from Tankovich. Neither was there presented any finding nor any reason that a skilled artisan, without knowledge of the present invention, would have selected the references and combined them as the Examiner has proposed. It appears that the only source for the motivation to combine the references is the present invention. It is reasonable to infer that this combination of references was guided by hindsight based on Applicant's claims. Courts forbid the use of hindsight in the selection of references to support a rejection based upon obviousness. In re Rouffet, 149 F.3d at 1358. See In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Lacking a motivation to combine references, the Examiner has not established a *prima facie* case of obviousness.

Without proving any motivation to combine the references, without any finding of reasonable expectation of success, and without proving the references taught all the claim limitations, the Examiner has not made a *prima facie* case of 35 U. S. C. § 103 obviousness.

Accordingly, Applicant submits that the 35 U. S. C. § 103 rejection of claims 1, 2 and 4-12 is overcome. Favorable consideration, culminating in allowance of claims 1, 2 and 4-12 is respectfully requested.

The Commissioner is hereby authorized to charge any fees which may be due to render this a timely response to the September 12, 2005 official action, to Applicant's undersigned counsel's deposit account 10-0435 with reference to file 6631-27092. A duplicate copy of this authorization is enclosed for this purpose.

Respectfully submitted



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